

First, it will be appreciated that the cancellation of claims 3, 4 and 19 renders the corresponding portions of this rejection moot.

Applicant's invention, as described in claim 1, involves a method of treating the surface of a substrate containing titanium for an ornament. This is accomplished by providing the surface containing titanium, eliminating substances adhered to substrate's surface from that surface, the adhered substances resulting from the substrate having been subjected to machine working by honing processing, nicking processing or mirror finishing, the adhered substances being foreign materials, forming a transparent protective layer containing glass by adhering a glass coating liquid on the surface from which the adhered substances have been removed and drying the surface.

Those skilled in the art will appreciate that the machine working procedures of honing processing, nicking processing, or mirror finishing have a decorative effect suitable for an ornament. Furthermore, these procedures help to produce a flat glass layer. None of the cited references, it will be appreciated, suggest these processes.

This rejection is traversed on grounds that not all of the claimed steps have been shown to be taught by the alleged admitted state of the art, the cited art, or the combination thereof. It is stated at page 3 that the admitted state of the art teaches the use of titanium and titanium alloys to form watches with a transparent protective film, and that oxidation of such materials can be a problem.

The rejection then admits that the admitted state of the art "fails to teach removing 'adhesion substances' from the titanium surfaces prior to applying the transparent protective layer".

It is respectfully submitted that neither the admitted state of the art nor the applied references suggests at least the aspects of claim 1 relating to the removal of adhered substances on the workpiece's surface which are themselves a foreign materials resulting from the machine working of the substrate using the specified processes.

The present invention, through the steps of machine working by honing processing, nicking processing, or mirror finishing, removing substances that adhere to the workpiece's surfaces, and then forming a transparent protective layer thereon, improves titanium or titanium alloy surfaces by making them more durable and resistant to scratches, fingerprints, corrosion and abrasion. Surface feel is also improved, making the objects more pleasant to the touch, and less likely to snag on or damage clothing. The specification **recognizes** these superior properties and gives numerous comparable examples showing the superiority of the claimed invention relative to the prior art, for example, in Tables 6 and 7 and the accompanying discussion, at pages 28-33 of the specification. Thus, by virtue of this invention, one can obtain a hard surface with excellent scratch resistance that is able to resist contamination by adhesions like fingerprints, as well as mechanical damage. Moreover, whiteness and glossiness are improved.

Applicant respectfully submits that such unexpectedly superior results constitute secondary indicia of non-obvious sufficient to establish the patentability of the claimed invention over the prior art.

In this regard, M.P.E.P. § 2141 states "[o]bjective evidence or secondary considerations such as unexpected results, commercial success, longfelt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these

secondary considerations is submitted, the examiner must evaluate the evidence." In this regard, the Examiner is also directed to M.P.E.P. § 716.02, which recognizes (in the context of affidavit evidence) that proof of unexpected superior results can be sufficient to establish nonobviousness of an invention.

The remaining rejected claims, claims 5-18, 20-24 and 40, all ultimately depend from and so incorporate by reference all the features of claim 1, including those features just shown to avoid the cited art. Claims 5-18, 20-24 and 40 therefore avoid the cited art at least for the reasons which have been given with regard to base claim 1.

For all the foregoing reasons, favorable reconsideration and withdrawal of this rejection are respectfully requested.

Claims 1, 3-24 and 40 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,298,332 to Andrus et al. in combination with U.S. Patent No. 4,906,524 to Takao, and further in combination with Thoma, Rothschild, Beaty, Angell, Fahrmbacher-Lutz, or Dotzer. Applicant respectfully traverses this rejection and submits the following arguments in support thereof.

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As for the remaining claims, claim 1 already has been summarized, and, for brevity, reference is now made to that summary.

Andrus suffers from the same deficiencies as Applicant's alleged admitted prior art. In particular, Applicant submits that Andrus does not suggest that the machine working be honing processing, nicking processing or mirror finishing, as is claimed.

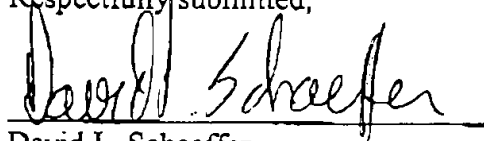
The claimed invention therefore patentably distinguishes over the cited art for the reasons just given with regard to the previous rejection. Accordingly, favorable reconsideration and withdrawal of this rejection are respectfully requested.

### CONCLUSION

Applicant respectfully submits that all outstanding rejections and objections have been addressed and are now either overcome or moot. Applicant further submits that all claims pending in this application are patentable over the prior art. Reconsideration and withdrawal of those rejections and objections is respectfully requested.

Applicant has made a diligent effort to place this application in condition for allowance and notice to the effect that claims 1, 5-18, 20-24 and 40 are in condition for allowance is earnestly solicited. Should, however, the Examiner deem otherwise, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below to resolve any outstanding issues prior to issuing a further Office Action.

Respectfully submitted,



David L. Schaeffer  
Registration No. 32,716  
Attorney for Applicant  
Stroock & Stroock & Lavan LLP  
180 Maiden Lane  
New York, New York 10038  
(212) 806-5400

Attachment: "Version With Marking To Show Changes Made"

**VERSION WITH MARKINGS TO SHOW CHANGES**

**IN THE CLAIMS:**

Please cancel claims 3, 4 and 19 without prejudice to or disclaimer of the subject matter presented therein.

Amend claim 1:

1. (Thrice Amended) A method of treating a surface of a substrate containing titanium for an ornament, comprising the steps of:

providing the surface containing titanium;

eliminating substances adhered to said surface of said substrate from said surface, said adhered substances resulting from the substrate having been subjected to machine working selected from the group consisting of honing processing, nicking processing and mirror finishing, wherein said adhered substances are foreign materials, and

forming a transparent protective layer containing glass by adhering a glass coating liquid on said surface [after removing] from which said adhered substances have been removed and drying said surface.